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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,358	06/27/2005	Guido Jordine	PR/4-32595A	1411

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NOVARTIS
CORPORATE INTELLECTUAL PROPERTY
ONE HEALTH PLAZA 104/3
EAST HANOVER, NJ 07936-1080

EXAMINER	
BADIO, BARBARA P	

ART UNIT	PAPER NUMBER
1612	

MAIL DATE	DELIVERY MODE
03/02/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/522,358	JORDINE ET AL.	
	Examiner	Art Unit	
	Barbara P. Badio	1612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3 and 8-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3 and 8-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *1/26/2005 and 6/27/2005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

First Office Action on the Merits

Specification

1. The disclosure is objected to because of the following informalities: missing "Brief Description of the Drawings".

Appropriate correction is required.

2. The use of the trademarks "Viozan" and "Ariflo" have been noted in this application. They should be capitalized wherever they appears and be accompanied by the generic terminology.

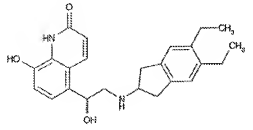
Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for pharmaceutically acceptable salts of



, does not reasonably provide enablement for solvates of said compound. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

Factors to be considered in making an enablement rejection are summarized as:

a) the quantity of experimentation necessary,

b) the amount of direction or guidance presented,

c) the presence or absence of working examples,

d) the nature of the invention,

e) the state of the prior art,

f) the relative skill of those in the art,

g) the predictability or unpredictability of the art, and

h) the breadth of the claims.

In re Colianni, 195 USPQ 150 (CCPA 1977). *In re Rainer*, et al., 146 USPQ 218 (CCPA 1965). *Ex parte Formal*, 230 USPQ 546 (BPAI 1986).

a) Determining if a particular compound would form a solvate or hydrate would require synthesis and recrystallization of the compound solvate or hydrate using a variety of solvents, temperatures and humidities. The experimentation for solvates or hydrates is potentially open-ended.

b) The specification merely mentions the Applicant's intention to make solvates and hydrates, without teaching the preparation thereof.

c) While the claims recite solvates and hydrates, no working examples show their formation. As stated in *Morton International Inc. v. Cardinal Chemical Co.*, 28 USPQ2d 1190, 1194 (Fed.Cir. 1993):

> The specification purports to teach, with over fifty examples, the preparation of the claimed compounds ... However ... there is no evidence that such compounds exist ... [T]he examples ... do not produce the postulated compounds ... [T]here is ... no evidence that such compounds even exist.

The specification shows no evidence of the formation and actual existence of solvates and hydrates. Hence, Applicant must show formation of solvates and hydrates or limit the claims accordingly.

d) The nature of the invention is chemical synthesis of solvates and hydrates, which involves chemical reactions.

e) The state of the art recognizes that the formation, composition and therapeutic activity of solvates and hydrates are unpredictable. The Federal Circuit has recognized a solvate as an example of a polymorph or pseudopolymorph (emphasis added):

> "Polymorphs" are distinct crystalline structures containing the same molecules. These structural differences can affect various properties of the crystals, such as melting points and hardness (e.g., graphite and diamonds are both crystalline forms of carbon) .... [P]seudopolymorphs are often loosely called polymorphs ... Pseudopolymorphs not only have their molecules arranged differently but also have a slightly different molecular composition. A common type of pseudopolymorph is a solvate, which is a crystal in which the molecules defining the crystal structure "trap" molecules of a solvent. The crystal molecules and the solvent molecules then bond to form an altered crystalline structure.

SmithKline Beecham Corp. v. Apotex Corp., 74 USPQ2d 1398, 1409 (Fed.Cir. 2005).

The same rationale obtains for hydrates; solvates in which the solvent is water. Souillac, et al., Characterization of Delivery Systems, Differential Scanning Calorimetry, pages 217-218 (in Encyclopedia of Controlled Drug Delivery, 1999, John Wiley & Sons, pages 212-227), recognize that different polymorphs of the same drug can have different therapeutic activity (emphasis added):

> Because different polymorphic forms of the same drug exhibit significant differences in their physical characteristics, therapeutic activity from one form to another may be different. Studying the polymorphism of a drug and the relative stability of the different polymorphs is a critical part of pre-formulation development.

Further, Vippagunta et al. (Advanced Drug Delivery Reviews, 48 (2001), pages 3-26) state "Predicting the formation of solvates or hydrates of a compound and the number of molecules of water or solvent incorporated in to the crystal lattice of a compound is complex and difficult." See page 18, section 3.4.

f) The artisan using Applicant's disclosure to prepare the claimed solvates and hydrates would be, e.g., an experienced process chemist with at least a BS chemistry degree.

g) Chemical reactions are known as unpredictable. *In re Marzocchi, et al.*, 169 USPQ 367, 370 (CCPA 1971); *In re Fisher*, 166 USPQ 18, 24 (CCPA 1970). See above regarding the unpredictability of solvate and hydrate formation.

h) The breadth of the claims includes thousands of compounds of the instant formula (1) as well as presently unknown compounds embraced by the terms solvates and hydrates. See MPEP 2164.01(a), discussed supra, justifying the conclusion of lack

of enablement commensurate with the claims. Undue experimentation will be required to practice Applicant's claimed invention.

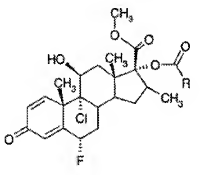
Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

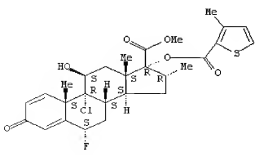
6. Claims 2, 3 and 8-13 are rejected under 35 U.S.C. 102(a) as being anticipated by Cuenoud et al. (WO 02/00679).

Cuenoud et al. teaches a genus of compounds of formula (I)



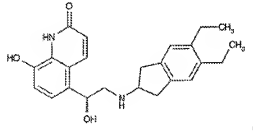
(I)

including



(see the entire article, especially page 16,

example 26; claims 1-13). The reference also teaches (a) the compounds as anti-inflammatory agents useful in treating conditions such as asthma, chronic obstructive pulmonary disease and atopic dermatitis (see the entire article, especially pages 7-11; page 12, 2nd paragraph – page 13, 1st paragraph), (b) co-administration of other agents including β_2-agonists such as:



(see page 11, 2nd paragraph – page 12, 1st paragraph) and (c) various routes of administration including inhalation (see page 13, 1st paragraph). The compositions and methods of use taught by the reference are encompassed by the instant claims.

Note: Crystalline forms do not exist in solution and, thus, the claimed composition will be identical to that of the prior art.

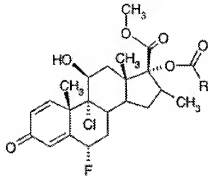
Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

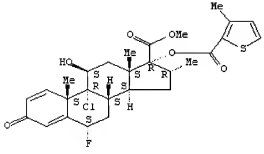
8. Claims 1-3 and 8-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cuenoud et al. (WO 02/00679).

Cuenoud et al. teaches a genus of compounds of formula (I)

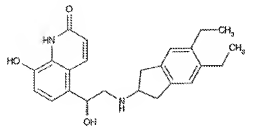


(I)

including



(see page 16, example 26; page 26, 3rd paragraph). The reference also teaches (a) the compounds as anti-inflammatory agents useful in treating conditions such as asthma, chronic obstructive pulmonary disease and atopic dermatitis (see the entire article, especially pages 7-11; page 12, 2nd paragraph – page 13, 1st paragraph), (b) co-administration of other agents including β_2-agonists such as:



(see page 11, 2nd paragraph – page 12, 1st paragraph) and (c) various routes of administration including inhalation (see page 13, 1st paragraph).

The instant claims differ in the recitation of a crystal form B and a method of preparing the claimed crystal form B. However purification of a compound by the production of the crystalline form of a compound is well known in the chemical and pharmaceutical arts and the cited reference teaches the production of a crystalline form of the claimed compound (see page 26, 3rd paragraph). Therefore, crystallization of the claimed compound would have been well within the level of skill of the ordinary artisan in the art at the time of the present invention. Additionally, the court has held that products which are merely different forms of known compounds are unpatentable where the products have the same utility as the prior art compounds. *Ex parte Hartop*, 139 USPQ 525; *In re Weijlard*, 69 USPQ 86; *Ex parte Conn and Norman*, 119 USPQ 388. As shown by the present specification, the claimed compound has similar utility as the prior art compound and, thus, the instant claims are unpatentable over the cited reference.

Claim 14 further differ from the reference by reciting a process for the production of claimed compound by crystallization from ethanol, methanol or methylene chloride. As stated above, Cuenoud et al. teaches a process for production of a crystalline form

of the claimed compound from isopropanol. Because isopropanol is a well known lower alcohol, it would have been obvious to the skilled artisan to utilize other lower alcohols such as ethanol and methanol in the purification of the prior art compound with the reasonable expectation of obtaining a crystalline form of the compound. Therefore, the claimed invention is prima facie obvious.

Telephone Inquiry

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P. Badio whose telephone number is 571-272-0609. The examiner can normally be reached on M-F from 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Barbara P. Badio/
Primary Examiner, Art Unit 1612